

REMARKS

Claims 1-20 remain in the application, claim 1 being independent. By the present amendment claim 1 has been amended. Support for the amendment to claim 1 can be found throughout the examples prepared according to the present invention.

The Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Kuyper '952 in view of WO 00/74843. The Examiner relies on Kuyper for the disclosure of preparing a polycarbonate from an epoxide, carbon dioxide and an active hydrogen compound in the presence of a double metal cyanide catalyst. The Examiner admits that Kuyper does not disclose the particular double metal cyanide (DMC) catalyst of the Applicant's claim. The Examiner relies on WO 00/74843 to disclose the DMC catalyst claimed by the Applicant. The Examiner states that it would be obvious to substitute the DMC catalyst disclosed in WO 00/74843 in the method of Kuyper.

Rejection of a claim under 35 U.S.C. § 103(a) requires that there be a teaching, suggestion, or motivation found within the prior art references themselves for making the Applicant's combination that is rejected as obvious. In addition, the Examiner must not ignore teachings found within the prior art references in making this evaluation.

In the present instance the primary reference Kuyper teaches that preparation of polycarbonates using DMC catalysts requires not only a DMC catalyst but also at least one co-catalyst comprising "one or more salts composed of at least bivalent metal ions and metal-free anions having a solubility in water of at least 1 g/100 ml at 25° C. and/or one or more no-metal containing acids of which a 0.1 N solution in water at 25° C. has a pH not exceeding 3". As can

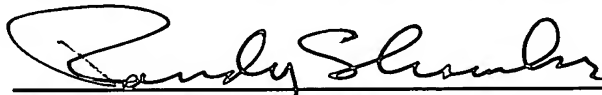
be seen by the present invention neither of these co-catalysts as they are called in Kupyier are required when utilizing the DMC catalyst of the present invention. There is no disclosure or analysis by the Examiner of what would make it obvious to remove the essential co-catalyst disclosed in Kupyier et al. to produce Applicant's claimed invention. In addition, the Examiner is directed to the present specification wherein numerous prior art DMC catalysts are attempted to be utilized in the present invention. It was found that all prior art DMC catalysts produce polycarbonates having extremely wide molecular weight distributions. By way of contrast the present invention and DMC catalyst produce a polyethercarbonate having a very narrow polydispersity. As disclosed in the specification the polydispersity of a polyol is defined as "the weight average molecular weight divided by the number average molecular weight". The Examiner is directed to paragraph 65 on page 25 of the present specifications. A monodispersed polyol would have a value of 1.0. All polyols prepared according to the present invention have polydispersities of less than 2.0 whereas those prepared using prior art catalyst all have values well above 2.0. There is no disclosure within the secondary reference of the polydispersity of conventional polyols prepared using the DMC catalyst disclosed in the secondary reference.

Because claim 1 as amended includes limitations neither found in nor made obvious based on either of the cited references taken alone or in combination the rejection of claim 1, and the claims which depend therefrom, under 35 U.S.C. § 103(a) based on the cited references is improper and should be withdrawn.

Accordingly, it is respectfully submitted that the Application, as amended, is now presented in condition for allowance, which allowance is respectfully solicited. Applicant believes that no fees are due, however, if any become required, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account 08-2789. Further and favorable reconsideration of the outstanding Office Action is hereby requested.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS

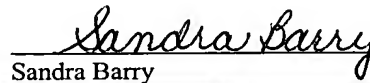


Randall L. Shoemaker, Reg. No. 43,118  
Howard and Howard Attorneys, P.C.  
The Pinehurst Office Center, Suite 101  
39400 Woodward Ave.  
Bloomfield Hills, MI 48304-5151  
(248) 723-0425

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Date

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I hereby certify that this paper or fee is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Box: AF . Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on December 10, 2003.

  
Sandra Barry

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